

A
Cont.

25. (New) The disposable absorbent article of claim 20, wherein the viscosity enhancing agent is an alcohol selected from the group consisting of cetyl alcohol, stearyl alcohol, behenyl alcohol, and mixtures thereof.

REMARKS

New claims 21-25 have been added to further define the present invention. Bases for these new claims can be found on Page 15, lines 24-32; Page 5, lines 27-29; and Page 10, lines 20-21, 28-30, and 36-37. No new matter is added. Entry is believed to be proper and respectfully requested.

Rejections under 35 USC §103(a) over Roe et al. in view of Wenninger et al.

The Examiner rejected Claim 20 under 35 U.S.C. §103(a) over U.S. Patent No. 5,609,587, issued to Roe et al. (hereinafter "Roe"), in view of *International Cosmetic Ingredient Dictionary and Handbook* by Wenninger et al. (hereinafter "Wenninger"). The Examiner suggested that Roe discloses a diaper having a lotioned topsheet, wherein the lotion composition contains ingredients similar to those of the presently claimed composition, and that disposable absorbent article can be a sanitary napkin, a panti-liner, a diaper, an incontinence brief, etc. The Examiner acknowledged that Roe does not teach the specific film-forming agents as claimed. However, the Examiner stated that Wenninger discloses acrylate copolymers (Vol. 1, pp. 26-27) and polyethylene (Vol. 2, pp. 1067-1068) as film formers and that these materials can be used in appropriate amounts in the lotion composition disclosed by Roe. The Examiner concluded that it would be obvious to combine these references.

Applicants respectfully traverse.

Applicants point out that the cited references provide no teaching or suggestion with respect to the rub-off and wash-off resistant composition of the present invention (Page 1, lines 8-11). Applicants also point out that Roe discloses several optionally ingredients that may be used in a composition (Col. 23, lines 27-44), and Wenninger is a handbook that includes several thousand chemical compounds useful for various applications. Numerous combinations can be chosen from the optional ingredients and chemical compounds of Roe/Wenninger. One of ordinary skill in the art must first choose to focus on the film forming agents, among various optional ingredients disclosed by Roe, then choose among various compounds listed in Wenninger that may be used as film forming agents, in order to arrive at the presently claimed invention. One must accomplish all this without any guidance from the references, since the Examiner has provided no motivation based on Roe/Wenninger that would lead one of ordinary skill in the art to specifically look into film forming agents, among various optional ingredients and compounds disclosed by Roe and Wenninger, in developing the rub-off, wash-off resistant composition of the present invention. Applicants respectfully submit that the Examiner has relied on Applicants' disclosure of a composition comprising a film forming agent in picking and choosing among various

→ not claimed
by applicants

optional ingredients taught by the references. Such hindsight reconstruction of a claimed invention is improper. *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

Further, Roe/Wenninger merely teach the use of optional ingredients in appropriate amounts in Roe's composition and article containing such composition. The possible selection of each optional ingredient is numerous. The proper amount of each selected ingredient must be separately determined. Thus, the teaching of Roe/Wenninger is, at best, an invitation to explore technologies using various optional ingredients. It does not arise to an enabling disclosure of such specificity as to place the invention in the possession of the public. The Court has held that references relied on to support a rejection under 35 U.S.C. §103 must provide an enabling disclosure. *In re Payne*, 203 USPQ 245 (CCPA 1979). Therefore, Applicants respectfully submit that the rejection based on Roe/Wenninger cannot be sustained.

Based on the foregoing, Applicants respectfully submit that the Examiner has failed to establish a *prima facie case* of obviousness. Reconsideration and withdrawal of this rejection are respectfully requested.

CONCLUSION

The above represents a complete response to the rejection under 35 U.S.C. §103. Applicants believe that this response places Claims 20-25 in condition for allowance. Reconsideration, withdrawal of rejection and a notice of allowance are respectfully requested.

Respectfully submitted,
For: Klofta et al.


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